

### **REMARKS**

Claims 9 and 23-41 are currently pending in the present application. Claims 9 and 23 have been amended herein, support for which may be found in the specification, at least, at page 9, the first, second and third paragraphs. No new matter has been added by way of the present claim amendments.

Applicants respectfully submit that no new issues are raised that would present the Examiner with the burden of additional search and/or consideration. For instance, Applicants are simply clarifying arguments already of record. In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

#### ***Rejection under 35 U.S.C. 112, First Paragraph***

Claims 9 and 23-41 stand rejected as containing new matter.

With all due respect, Applicants strenuously disagree with the outstanding rejection. As Applicants indicated in the previous response, the support for the claimed invention may be found in the specification, at least, at page 10, lines 3-16 and page 14, lines 23-25. However, in order to expedite prosecution, Applicants have amended the present claims to recite a screening method for substances “*that have a mechanism of pharmacological action similar to that of pioglitazone*” (emphasis added). This is clearly supported in the specification at page 9, the first paragraph. Thus, Applicants respectfully submit that the outstanding rejection has been rendered moot. Reconsideration and withdrawal are respectfully requested.

The Examiner also alleges that claims 9, 36 and 37 are not fully supported because of the term “addition”. Applicants respectfully traverse, however in order to expedite prosecution, Applicants have deleted the term “addition” from the portion of the noted claims that have numerical limitations on the number of deletions, substitutions or insertions. With respect to the “additions”, it is well known that additional amino acids can be added to the end of a sequence

and the sequence can still retain the desired activity. Therefore, it is not necessary to include an upper limit on the number of additions to the claimed sequence. The amended claims address the concerns raised by the Examiner and are fully supported by the disclosure at page 9, second and third paragraphs of the specification. Withdrawal of the outstanding rejection is respectfully requested.

***Rejection under 35 U.S.C. 112, Second Paragraph***

Claims 9, 23-31 and 36-38 stand rejected as being indefinite.

Without acquiescing to the outstanding rejection, Applicants have amended the present claims to further define the “thiozolidine derivative” as “selected from the group consisting of pioglitazone, rosiglitazone, trolitazone or ciglitazone”. This is in accordance with the Examiner’s comments in the Office Action at page 3, the fourth full paragraph, and is fully supported by the specification at page 9, the first paragraph. Accordingly, Applicants respectfully request withdrawal of the outstanding rejection.

***Rejection under 35 U.S.C. 102***

Claims 9, 23-27, 32, 33 and 38-41 stand rejected as being anticipated by US Patent Publication 2007/0105122 to Ota et al. (hereinafter “Ota”).

Claims 9, 23-33 and 38-41 stand rejected as being anticipated by US Patent Publication 2007/0224201 to Wu et al. (hereinafter “Wu”).

Applicants respectfully traverse each of the outstanding rejections. Applicants submit that neither of Ota nor Wu teach or suggest the claimed screening method for substances that have a mechanism of pharmacological action similar to that of pioglitazone.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Ota and Wu do not teach each and every element of the presently claimed invention. Thus, Ota and Wu cannot properly anticipate the presently claimed invention, within the meaning of 35 U.S.C. 102. Reconsideration and withdrawal are respectfully requested.

***Rejection under 35 U.S.C. 103***

Claims 34 and 35 stand rejected as being rendered obvious by Wu in view of the present specification at page 15.

Applicants respectfully traverse. Claims 34 and 35 further limit the scope of claims 9 and 23, respectively. As noted above, Wu does not teach or suggest the claimed screening method for substances that have a mechanism of pharmacological action similar to that of pioglitazone. Thus, the outstanding rejection is rendered moot. Withdrawal thereof is respectfully requested.

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By *[Signature]* (12/24/08)  
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